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10/655,877	09/05/2003	Rajnish Batlaw	5576A	7186

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Milliken & Company  
P.O. Box 1927  
Spartanburg, SC 29304

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/655,877

Applicant(s)

BATLAW ET AL.

Examiner

John m Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***Specification***

Applicants' specification is objected to because, while the application papers indicate this application to be a "Continuation", the specification recites the application to be a "Divisional". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are confusing as to intent because the "at least one black coloring agent" and the "toner compound" are not mutually exclusive species, and it can not be determined if applicants' claims are open to the inclusion of only one colorant in their compositional make-up to accomplish the role of the "at least one black coloring agent" and part or all of the "toner" component.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the employment of multiple colorants, does not

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reasonably provide enablement for the employment of one colorant to achieve the coloring effects of their invention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Applicants' enabling disclosure requires the employment of distinct materials to fulfill the role of the black colorant and the toner component. As the claims currently stand, they are open to the employment of only one black colorant to meet the criteria of the two claimed agents in whole or in part (in the case of the toner combination).

Claims 9-12 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' supporting disclosure is not supportive of the toner combination of compounds that comprises a first compound exhibiting a single absorption peak and a  $\lambda_{\max}$  between 560 and 575 nm and a second compound exhibiting a single absorption peak and a  $\lambda_{\max}$  between 576 and 610 nm. This is a new matter rejection.

Claims 18-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 18 recites the limitation "at least one of the compositions of steps "a" and "b" " in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rekers et al.(4,846,846).

Rekers et al. discloses preparations of polyurethane foams containing coloring additives which read on the materials claimed by applicants (see the entire document). The absorption values are held to be inherent features possessed by the articles of Rekers et al. in light of the teaching's selection of coloring elements.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ragsdale et al.(5,731,398)

Ragsdale et al. discloses preparations of polyurethane foams containing coloring additives which read on the materials claimed by applicants (see the entire document). The absorption values are held to be inherent features possessed by the articles of Ragsdale et al. in light of the teaching's selection of coloring elements.

While the blacking and bluing effects may be imparted by two discrete components in applicants' embodiments, the effects of applicants' products as claimed are seen to be met by the disclosed colored products of Ragsdale '398 and the methods of their preparation. No difference is seen to be evident between the ultimate products realized by Ragsdale et al. '398 and the products as claimed. Based on the similarities in compositional make-up of the products ultimately realized, no qualitative features of the claims have been identified which patentably distinguish the claims in the instant case, nor are differences seen to reside in methods based on their incorporation into polyurethane forming compositions.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ragsdale et al.(6,642,283)

Ragsdale et al. discloses preparations of polyurethane foams containing coloring additives which read on the materials claimed by applicants (see the entire document). The absorption values are held to be inherent features possessed by the articles of Ragsdale et al. in light of the teaching's selection of coloring elements.

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While the blacking and bluing effects may be imparted by two discrete components in applicants' embodiments, the effects of applicants' products as claimed are seen to be met by the disclosed colored products of Ragsdale '283 and the methods of their preparation. No difference is seen to be evident between the ultimate products realized by Ragsdale et al. '283 and the products as claimed. Based on the similarities in compositional make-up of the products ultimately realized, no qualitative features of the claims have been identified which patentably distinguish the claims in the instant case, nor are differences seen to reside in methods based on their incorporation into polyurethane forming compositions.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No.

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6,642,283. Although the conflicting claims are not identical, they are not patentably distinct from each other because the articles of the patented claims overlap in a manner which would have been obvious to one having ordinary skill in the art. The claims of 6,642,283 disclose variation and/or multiplicity in the selection of coloring agents for the preparations for the purpose of achieving adequate black coloration of their articles such that selections as claimed would have been obvious to one having ordinary skill in the art with the expectation of success. Additionally, the claims of 6,642,283 are directed towards polyurethane articles and preparing those articles by means of incorporating the coloring agents into the reactants for the purpose of achieving uniform integration of coloring agent in the product would have been obvious to one having ordinary skill in the art with the expectation of success.

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/400,216. Although the conflicting claims are not identical, they are not patentably distinct from each other because the articles of the copending claims overlap in a manner which would have been obvious to one having ordinary skill in the art. The claims of 10/400,216 disclose variation and/or multiplicity in the selection of coloring agents for the preparations for the purpose of achieving adequate black coloration of their articles such that selections as claimed would have been obvious to one having ordinary skill in the art with the expectation of success. Additionally, the claims of 10/400,216 are directed towards polyurethane articles and preparing those



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articles by means of incorporating the coloring agents into the reactants for the purpose of achieving uniform integration of coloring agent in the product would have been obvious to one having ordinary skill in the art with the expectation of success.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/400,961. Although the conflicting claims are not identical, they are not patentably distinct from each other because the articles of the copending claims overlap in a manner which would have been obvious to one having ordinary skill in the art. The claims of 10/400,961 disclose variation and/or multiplicity in the selection of coloring agents for the preparations for the purpose of achieving adequate black coloration of their articles such that selections as claimed would have been obvious to one having ordinary skill in the art with the expectation of success. Additionally, the claims of 10/400,961 are directed towards polyurethane articles and preparing those articles by means of incorporating the coloring agents into the reactants for the purpose of achieving uniform integration of coloring agent in the product would have been obvious to one having ordinary skill in the art with the expectation of success.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/400,362. Although the conflicting claims are not identical, they are not patentably distinct from each other because the articles of the copending claims overlap in a manner which would have been obvious to one having ordinary skill in the art. The claims of 10/400,362 disclose variation and/or multiplicity in the selection of coloring agents for the preparations for the purpose of achieving adequate black coloration of their articles such that selections as claimed would have been obvious to one having ordinary skill in the art with the expectation of success. Additionally, the claims of 10/400,362 are directed towards polyurethane articles and preparing those articles by means of incorporating the coloring agents into the reactants for the purpose of achieving uniform integration of coloring agent in the product would have been obvious to one having ordinary skill in the art with the expectation of success. Additionally, the articles achieved by the methods claimed would have been obvious to one having ordinary skill in the art as the achievement of these articles is the purpose of the methods and no patentable distinction is seen between the products and methods for their formation.


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DiBella et al. discloses colorants in related fields of endeavor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JOHN M. COONEY, JR.**  
**PRIMARY EXAMINER**  
Group 1700